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7590		08/21/2007	EXAMINER	
Louis Tessier		WILLIAMS, MARK A		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/748,857	Applicant(s) CORNFIELD, RANDALL	
	Examiner Mark A. Williams	Art Unit 3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added claim language directed to “substantially rectilinear” was not described in the specification or drawings in such a manner enabling one skilled in the art to make and/or use the device, and constitutes new matter.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim language directed to “substantially rectilinear” is not fully understood in the context of the invention.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herron et al., US Design Patent Des, 295,011, in view of Mosley, US Design Patent Des.397,018.

See below figures. Herron provides the general claimed handle including a generally elongated body (as best understood, the body is substantially rectilinear) defining a body longitudinal axis, a body forward end for connection to said implement head and a longitudinally opposed body rearward end; said body also defining a body top surface and a substantially opposed body bottom surface; said

body defining an encirclable section located intermediate said body forward and rearward ends, said encirclable section being configured and sized so as to be graspable between at least a portion of a user's palm and at least a portion of at least either one of the user's middle, ring or small fingers at least partially encircling said encirclable section; said body top surface being provided with an identifiable thumb rest area located intermediate said encirclable section and said body forward end for contacting at least a portion of the distal pulp of said thumb, said thumb rest area defining a rest area forward most location; said body bottom surface being provided with a substantially concave indentation defining an indentation surface located intermediate the encirclable section and said body forward end for contacting at least a portion of one of said finger lateral surfaces of said index finger with the latter in substantially perpendicular relationship with said body longitudinal axis; said indentation surface having a substantially arcuate cross-sectional configuration defining an indentation first end located substantially adjacent said encirclable section and an indentation second end located substantially adjacent to said body forward end; said body defining a cross-sectional first reference plane extending in a substantially perpendicular relationship with said body longitudinal axis and in register with said indentation second end, said indentation surface being configured and sized so that at least a section of said

indention surface is positioned forwardly relative to said first reference plane. The thumb rest is offset relative to the indention, as claimed. The encirclable section is fusiform. An abutment section and the neck section together defining a thumb rest area on the body top surface, and an index rest area on the body bottom surface; said abutment section tapering forwardly into a spacing section for spacing the fingers from the implement head. The neck section defines a top surface nadir and a bottom surface nadir, as claimed. Top surface and bottom surface peaks as claimed are inherent. In use, the device is capable of being used such that said intended user is able to position said thumb so that said distal pulp thereof abuttingly contacts said thumb rest area and to position said middle, ring and small fingers such that said middle, ring and small finger are wrapped around said encirclable section for pressing said encirclable section against said palm while said index finger is positioned in said indentation with at least a portion of said one of said finger lateral surface thereof and said pulp section thereof in abutting contact with said indentation surface, as claimed.

Regarding claims 1-3, 6-14, 16, 18, 19, 26-28, 33, and 35-37, Herron provides the claimed invention except explicit teaching of (1) at least a section of the intention surface being located forwardly to a reference plan intersecting an indention surface end point, as claimed; and (2) the encirclable section having a

substantially fusiform configuration, as claimed. Mosley teaches these general concepts in a particular handle design. Such a design creates a particular visual appearance that may be desired. In addition, one skilled in the art would know that the particular indentation shape provides additional shielding to the finger of a user. It would have been obvious to include such modifications in the design of Herron for the purpose of achieving a particular visual appearance of the handle as well as additional shielding means for a users finger during use of the knife.

Note that in use, the resulting device is capable of being used such that said intended user is able to position said thumb so that said distal pulp thereof abuttingly contacts said thumb rest area and to position said middle, ring and small fingers such that said middle, ring and small finger are wrapped around said encircable section for pressing said encircable section against said palm while said index finger is positioned in said indentation with at least a portion of said one of said finger lateral surface thereof and said pulp section thereof in abutting contact with said indentation surface, as claimed.

Regarding claim 4, Herron does not explicitly state the claimed values of a reference plane. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use such values, since it has been held that discovering an optimum value of a result effective variable involves only routine

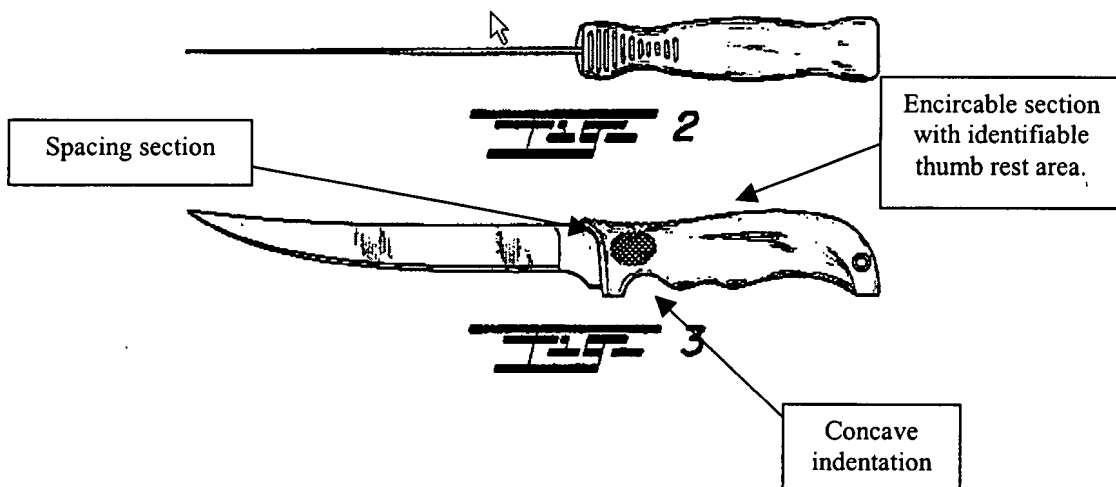
skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Such a modification would have produced no unexpected results, and is not novel.

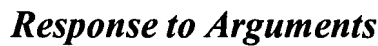
Regarding claims 17 and 20, top and bottom apexes, as well as indentation surface nadir and thumb rest area nadir, are inherent to the design. However, the particular sum of the distance as claimed is not explicitly disclosed. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device in this way, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Such a modification may help achieve a particular desired gripping feel as well as visual appearance of the handle.

Regarding claims 21-25, 29-31, Herron discloses the claimed invention except for the device being of different materials, as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the device in this way, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331. Such a modification would have produced no

unexpected results, and is not novel. On advantage to such a modification is that such a material would add in the gripping of the device.

Regarding claims 5, 15, 32, and 34, although these particular limitations are not explicitly shown, it would have been an obvious matter of design choice to make the different portions of the device of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47. Such modifications are not critical to the design and would have produced no unexpected results. One reason for such modification may be for achieving a desire appearance of the handle.





Applicant argues that the structure directed to “a generally elongated and substantially rectilinear body”, “an encirclable section”, “an identifiable thumb rest area”, “a substantially concave indentation”, and “a substantially actuate cross-sectional configuration defining an indentation first end.... a substantially fusiform configuration” is not shown by the applied art of Herron. However, as pointed out in the above rejection, as well as shown in the attached drawings, each of these limitations are disclosed by the obvious combination of Herron and Mosley.

Applicant argues that Herron does not provide indentation structure that curves back longitudinally towards the rear of the knife. First, such structure is not found in the claim language. Second, the resulting combination would indeed

provide this structure, since the indentation of Mosley does curve back in this manner.

Applicant argues that Mosley does not provide a rectilinear body. However, Herron, as best understood, does provide such structure, and Mosley is merely relied on for the particular teaching of the indentation shape, as well as the concept of fusiform tapered shape. To combine these aspects of the invention of Mosley into the general design of Herron is considered obvious.

Applicant argues that the particular claimed handle design provides for specific utility with an improved ergonomically grip by a user. However, the claimed limitations are met by an obvious combination of Herron in view of Mosley, as outlined above. The particular intended utility of applicant's invention does not carry any patentable weight in overcoming such an art rejection.

Applicant argues that there is no motivation to combine Herron and Mosley as applied, and that the handles are intended to be used differently. However, it is the position of the examiner being that both handles are knife handles and intended to be used in the same applications, to borrow particular features from one handle so as to be added to the aesthetic appeal, as well as utility, of the other handle is obvious, as outlined in the above rejection. One skilled in the art would may have the motivation to combine Herron and Mosley for the purpose of achieving a

particular visual appearance of the handle as well as additional shielding means for a users finger during use of the knife.

Note that applicant has provided no arguments to the examiner's indication of Official Notice and design choice rejections in prior Office actions. It is therefor the position of the Office that applicant concedes the examiner's indication of Official Notice and design choice as being proper.

Conclusion

This action is non-final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Williams whose telephone number is (571) 272-7064. The examiner can normally be reached on Monday through Friday.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark Williams
8/14/07



JENNIFER H. GAY
SUPERVISORY PATENT EXAMINER